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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,994	11/26/2003	Tomohiro Miyashita	XA-9999	6540
181	7590	07/25/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/721,994	Applicant(s) MIYASHITA, TOMOHIRO	
	Examiner Joshua L. Pritchett	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/03, 2/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This action is in response to Election and Amendment filed June 6, 2005. Claims 1-11 have been elected without traverse and claim 19 has been added as requested by the applicant.

### ***Election/Restrictions***

Applicant's election of claims 1-11 in the reply filed on June 6, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Objections***

Claim 8 is objected to because of the following informalities: claim 8 includes limitations regarding the magnification state  $\alpha$ , which lacks support in parent claim 4. The examiner believes the claim should properly depend from claim 7 and will examine the claim as if it depended from claim 7. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 9-11 rejected under 35 U.S.C. 102(b) as being anticipated by Otaki (US 6,128,128).

Regarding claim 1, Otaki discloses a microscope system (Fig. 1) comprising an objective lens (L1) and an intermediate magnification varying part disposed just after the image side of the objective lens (L2-L8; Figs. 6 and 8).

Regarding claim 2, Otaki discloses the intermediate magnification varying part includes a lens group having a positive refractive power and a lens group having a negative refractive power and in high magnification the lens group having a positive refractive power disposed just after the image side of the objective lens (Fig. 6; magnification 10x; objective L1, positive power L2; negative power L3 and L4 cemented together) while in a low magnification the lens group having a negative refractive power is disposed just after the image side of the objective lens (Fig. 8; magnification 2x; objective L1; positive power L8; negative power L2).

Regarding claims 3 and 5, Otaki discloses the intermediate magnification varying part is constructed in such a way that its optical system is rotatably with an axis substantially orthogonal to an optical axis being a rotation axis (Figs. 1 and 2). Fig. 1 shows that the optical axis of the light beam through the microscope bends at several locations providing several different optical axes. Fig. 2 shows the rotation axis (20 Ax), which in the broadest reasonable interpretation of

the phrase "substantially orthogonal" meets the claim limitations for one of the optical axes shown in Fig. 1.

Regarding claims 4, 6 and 9-11, Otaki discloses the microscope optical system is provided with a connecting portion (20) on the image side of the intermediate magnification varying part and the microscope optical system can be connected with a body of a microscope by means of the connecting portion (Fig. 1).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Yonezawa (US 6,320,702).

Otaki teaches the invention as claimed but lacks reference to the claimed magnification state ratios. Yonezawa teaches moving lenses within the intermediate magnification varying part along the optical axis to change the magnification (abstract). After combining the teachings of both Otaki and Yonezawa one of ordinary skill in the art would be able to set the magnification to a wide variety of settings, which depending on the preference of the operator would fall within

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the claimed magnification ranges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Otaki invention include the movable lenses of Yonezawa in the intermediate magnification varying part for the purpose of allowing both rough and fine tuning adjustments to the magnification state of the microscope to allow observation of large areas and quickly be able to zoom in or out of smaller areas within the large area of observation.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki in view of Saito (US 6,188,514).

Otaki teaches the invention as claimed but lacks reference to the claimed Abbe number and working distance relationship. Saito teaches the objective lens (4) comprises in order a first lens group and a second lens group (first group before d20 and second group after d20; Fig. 3) the first lens group includes a positive meniscus lens with the concave surface facing the object side (lens between r1 and r2; Fig. 3) and one or more cemented lenses (lenses between r9 and r11; Fig. 3) the first lens group having a positive refracting power as a whole (Fig. 3) at least one of the cemented lenses includes a lenses having an Abbe's number equal to or greater than 80 (Table 1) and the following conditions satisfied  $0.3 \leq wd/f \leq 0.45$  (col. 11 lines 20-22), Saito teaches a ration of 0.42, and  $0.6 \leq NA$  (col. 11 line 21), Saito teaches a numerical aperture of 0.95, where wd is the working distance, f is the focal length and NA is the numerical aperture.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 

  
**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**